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09/888,044	06/22/2001	Grover Blackwell	NHS-2	6965
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			RHEE, JANE J	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/888,044

Filing Date: June 22, 2001

Appellant(s): BLACKWELL ET AL.

Dority & Manning, P.A.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 2/24/2005.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(7) *Prior Art of Record***

5,848,505	Taylor	12-1998
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6,014,839	Ruggles	1-2000
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**(8) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable by Taylor (5848505) in view of Ruggles (6014839).

Taylor discloses a face panel made from a synthetic polymer (col. 2 line 45), the face panel including a first vertical end portion and a second vertical end portion (col. 2 line 36-37), a first rear vertical support and a second rear vertical support attached to the face panel (col. 2 line 54), the rear vertical support being spaced apart and extending along the length of the face panel (figure 2 number 16), the first rear vertical support being positioned adjacent to the first vertical end portion and the second rear vertical support being positioned adjacent to the second vertical end portion (figure 2 number 16) and at least one rear horizontal support attached to the face panel (figure 2 number 19) and rear horizontal support extending in between the pair of rear vertical supports (figure 2 number 19), and a first channel member and a second channel member each of the channel members having a u-shaped cross section, the first channel member being place over the first vertical end portion and the first rear vertical support and the second channel member being placed over the second vertical end portion and the second rear vertical support (figure 2). Taylor discloses that the face panel is made from an expanded foam polyvinyl chloride (col.2 lines 45-47). Taylor

discloses that the first and second rear vertical supports and at least one rear horizontal support are made from an expanded foam polyvinyl chloride (col. 2 line 52). Talyor discloses that the first and second vertical supports are attached to the face panel using an adhesive (col. 2 lines 52-57). Taylor discloses that each of the vertical end portions and the rear vertical supports include indentations and wherein the channel members define raised elements that reside in the indentations (figure 2 number 17). Taylor discloses that the shutter includes at least two rear horizontal supports (col. 4 line 17-18). Taylor discloses a polymer film positioned in between the face panel and the first and the second rear vertical supports and between the face panel and at least one horizontal support (col. 3 lines 19-20). Taylor discloses that the first and second channel members are made from aluminum (col. 3 line 12). Taylor discloses routed out decorative areas (col. 2 lines 49-51). Taylor discloses that the first and second channel members extend the entire length of the face panel (figure 2 number 14). Taylor discloses that the indentations located on the vertical end portions and the rear vertical supports comprise vertical slots and extend the length of the shutter, and wherein the raised elements defined by the channel members also extend the length of the shutter (figure 2 number 17).

Taylor fail to disclose that the channel members being made from a metal. Ruggles teaches that the channel members maybe constructed from of any suitable material or combination of materials, including but not limited to wood, metal, plastics, ceramics, and combinations thereof (col. 6 lines 10-14), therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made

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to provide Taylor with the channel members being made from a metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. In re Leshin, 125 USPQ 416.

Taylor fail to disclose that the face panel is coated with a lacquer coating. Taylor teaches repainting of the shutters periodically during the life of the shutter to prolong the lifespan of the shutter (col. 5 lines 21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide the face panel with a coating of lacquer to prolong the lifespan of the shutter as taught by Taylor. (col. 5 line 21).

Furthermore, applicant amended the independent claims 1, 11, and 17 to include the limitation that the first channel member being placed over and enclosing the first vertical end portion and the first rear vertical support and the second channel member being placed over and enclosing the second vertical end portion and the second rear vertical support, the first and second channel members forming exterior vertical edges of the shutter. Taylor discloses in figure 2 that the first channel member (left side number 11) is placed over and encloses the first vertical end portion (left side number 17) and the first rear vertical support (left side number 16) and the second channel member (right side number 11), is placed over and encloses the second vertical end portion (right side number 17) and the second rear vertical support (right side number 16), the first and second channel members forming exterior vertical edges of the shutter (right and left side number 11).

**(9) Response to Argument**

Appellant argues that Taylor fails to disclose or suggest channel members made from a metal that form the exterior edges of a shutter.

In response to appellant's argument that Taylor fails to disclose the first and second metal channel members that form exterior vertical edges of a shutter, the applicant merely claims that the first channel member and the second channel member is made of metal, therefore, Talyor discloses that the first and second channel members are made from aluminum (col. 3 line 12) because applicant did not claim that the first and second channel members are entirely made of metal. Part of Taylor's first and second channel members is made of aluminum and even if the aluminum parts of the first and second channel member are considered as inserts in the first and second channel members, the first and second channel members as a whole comprises the aluminum insert therefore the first and second channel members is made of metal. Furthermore, prior art Ruggles teaches that the frame of the can be made of metal among other practical materials and since the first and second channel members frame applicant's shutter, it would have been obvious to provide Taylor with the first and second channel members to be made of metal since it has bee held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. In re Leshin, 125 USPQ 416.

Appellant argues that Taylor teaches away from a shutter that includes exposed areas made from a metal and teaches away from including metal channel members that form the exterior edges of the shutter.

In response to appellant's argument that Taylor teaches away from a shutter that includes exposed areas made from metal and teaches away from including metal channels members that form the exterior edges of the shutter, appellant broadly claimed that the first and second channel member each having a U-shaped cross section and being made of metal, therefore, since the aluminum rods are considered part of the U-shaped first and second channel, the examiner broadly considers the first and second channel member each having a U-shaped cross section and being made of metal. As to Taylor teaching away from a shutter that includes exposed areas made from metal and teaching away from including metal channels members that form exterior edges of the shutter, appellant did not claim that the shutter includes "exposed areas made from metal" nor did the appellant claim "metal channels members that form exterior edges of the shutter". Appellant merely claimed that the first and second channel member each having a U-shaped cross section and being made of metal. Again, as discussed above, appellant did not claim that the entire first and second channel members are being made of metal, part of Taylor's first and second channel members is made of aluminum and even if the aluminum parts of the first and second channel member are considered as inserts in the first and second channel members, the first and second channel members as a whole comprises the aluminum insert therefore the first and second channel members is made of metal.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Taylor and Ruggles both teach a shutter assembly that includes a pair of stiles that are parallel to one another and extend vertically and a top rail and a parallel bottom rail that extends between the stiles wherein the shutter assembly is made from plastic material. Ruggles further teaches that the stiles, top rail and bottom rail which constitute the frame of the shutter assembly may be made of any suitable material or combination of materials including wood, metal, plastics ceramics and combinations thereof (col. 6 lines 10-14). Therefore, since Ruggles teaches that the frame of the can be made of metal among other practical materials and since the first and second channel members frame applicant's shutter, it would have been obvious to provide Taylor with the first and second channel members to be made of metal since it has bee held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

However, even without the combination of the secondary reference taught by Ruggles to teach that the first and second channel members are being made from metal, Taylor still discloses that the first and second channel members are made from

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metal such as aluminum (col. 3 line 12) because appellant did not claim that the first and second channel members are entirely made of metal. Furthermore, even if appellant argues that the first and second channel members that are made from metal are U-shaped and that Taylor does not disclose the first and second channel members being U-shaped with the combination of the aluminum rods, the first and second channel members of Taylor's shutters are U-shaped even with the addition of the aluminum rods because the vertical side members has two arms which extend the length of the vertical side members which are made to grip the complementary stepped projection shown in figure 5. Therefore, Taylor discloses a first channel member and a second channel member each of the channel members having a u-shaped cross section and being made of metal (col. 3 lines 7-16).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Jane Rhee  
June 7, 2005



PATRICK JOSEPH RYAN  
**SUPERVISORY PATENT EXAMINER**

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